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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,460	08/28/2003	Takeshi Kanaya	51028/DBP/A400	7118

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EXAMINER

BELL, KENT L

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

5/27

<b>Office Action Summary</b>	Application No. 10/650,460	Applicant(s) KANAYA ET AL.	
	Examiner Kent L. Bell	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

*application filed 8/28/03*

- 1) ☒ Responsive to communication(s) filed on 8/28/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/28/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/28/03</u>   | 6) <input type="checkbox"/> Other: _____                                    |

*K. L. Bell*

**Detailed Action**

**Objection to the Drawing**

The following is a quotation of section (a) of 37 CFR 1.165:

(a) Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure numbers and reference characters need not be employed unless required by the Examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual reproduction.

The submitted photographic illustrations filed August 28, 2003 are objected to under 35 CFR 1.165(a). By way of explanation, the photographic illustrations should not be mounted (37 CFR 1.84(e)).

The rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October 1, 2001. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at: <http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patwavr.htm>.

**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification

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must particularly point out the location and character of the area where the plant was discovered.

### 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical

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description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 1, line 6, Applicant's state the instant plant's Genus/species is "*Petunia hybrida*". However, during a UPOV-Rom search. A Calibrachoa plant named 'Sunbelho' was found. It is uncertain whether the instant plant and the Calibrachoa plant named 'Sunbelho' are the same. Applicants should verify whether they are the same plant. If they are the same plant, applicants should verify the correct Genus/species designation and set forth the correct Genus/species designation in the specification.

B. Page 1, lines 12 and 13, Applicants state "a few Petunia developed series of small flower petunias". This recitation is unclear as it is not understood what applicants mean. Correction and/or clarification is necessary.

C. Page 1, lines 31 and 32, Applicants should delete "at the Omi R&D Center of SUNTORY FLOWERS Ltd.," as this recitation constitutes unwarranted advertising (MPEP 1610). The current recitation without the recitation stated above is more than adequate.

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D. Page 2, line 4, Applicants should delete “the Omi R&D Center” as this recitation constitutes unwarranted advertising (MPEP 1610). Applicants should insert - -863-1, Aza-Iketani, Omori-cho, Yokaichi-shi, Shiga-ken, Japan- - in order to set forth where the trial took place.

E. Page 2, line 10, Applicants state the instant cultivar is “uniform and stable in its characteristics”. However, this recitation does not mean the instant plant reproduces true to type in successive generations of asexual reproduction. If the plant does reproduce true to type then applicant should also state in the specification - -The new variety reproduces true to type in successive generations of asexual reproduction.- -. If the plant does not reproduce true to type then applicants will be unable to obtain a U.S. Plant Patent on this particular cultivar.

F. Page 3, line 31, Applicants should delete “are” and should insert - -is- - in its place.

G. Page 3, line 33, Applicants should delete “at the Omi R&D Center of SUNTORY FLOWERS Ltd., located” as this recitation constitutes unwarranted advertising (MPEP 1610). The current recitation without the recitation stated above is more than adequate.

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H. Page 7, line 11, Applicants state Spreading area of plant is “Slightly large”. Applicants should set forth in the specification the typical and observed plant spread. The recitation “Slightly large” is vague and inadequate in this regard.

I. Page 7, lines 12-14, Applicants should set forth in the specification the time it takes the instant plant to flower.

J. Page 7, lines 15-20, Applicants should set forth in the specification additional information relative to the instant plant’s stems including the typical and observed stem length and coloration with reference to at least one of the employed color charts.

K. Page 7, lines 21-29, Applicants should set forth in the specification additional information relative to the instant plant’s leaves including the typical and observed leaf apex, margin, and base descriptors.

L. Page 7, line 25, Applicants set forth a coloration for the instant plant’s leaves. However, it is unclear whether the coloration set forth is for the upper, lower, or both surfaces. Applicants should set forth in the specification a coloration for the upper and lower leaf surfaces with reference to at least one of the employed color charts.

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M. Page 7, line 30, Applicants should set forth in the specification information relative to the instant plant's buds including the typical and observed bud shape, length, diameter, and coloration with reference to at least one of the employed color charts.

N. Page 7, line 30, Applicants should set forth in the specification whether the instant plant's flowers produce a fragrance. If a fragrance is produced, then such should be described in the specification. If a fragrance is not produced, applicants should simply state such in the specification.

O. Page 7, lines 34-36, Applicants should set forth in the specification additional information relative to the instant plant's petals including the typical and observed petal shape, apex and margin descriptors. The recitation "Medium" for petal tip shape does not describe a shape. The recitation "Waving of petal.- - Weak" simply means the petals are wavy, it does not describe the petal margin. The recitation "Lobation of petal.- - Shallow" simply means the petals have a shallow lobation, it does not describe the petal shape.

P. Page 7, line 37, Applicants set forth a diameter but it is unclear whether the diameter set forth is for the corolla or petal or other. Applicants should set forth in the specification the



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typical and observed corolla diameter and height, petal length and width, flower tube length, and flower throat diameter.

Q. Page 8, line 1, Applicants set forth a coloration for the instant plant's petals.

However, it is unclear whether the coloration set forth is for the upper, lower, or both surfaces.

Applicants should set forth in the specification a coloration for the upper and lower petal surfaces with reference to at least one of the employed color charts.

R. Page 8, lines 2 and 3, Applicants state the bottom of the corolla throat is 8A.

However, when compared to the photographic illustrations, in addition to the 8A coloration at the bottom of the corolla throat it appears there is also a greenish coloration present. Such should be meaningfully accounted for in the specification by setting forth a color designation with reference to at least one of the employed color charts. Applicants should also specify whether the 8A coloration is present on the inside or outside or both sides of the corolla throat.

S. Page 8, after line 4, before line 5, Applicants should set forth in the specification information relative to the instant plant's sepals including the typical and observed sepal number, length, width, shape, apex, base, and margin descriptor, and coloration (both surfaces) with reference to at least one of the employed color charts.

**Detailed Action**

T. Page 8, line 8, Applicants should set forth in the specification additional information relative to the instant plant's peduncle including the typical and observed peduncle coloration with reference to at least one of the employed color charts.

U. Page 8, lines 9-12, Applicants state Heat and Cold tolerance is "High". Applicants should set forth in the specification meaningful information relative to the instant plant's Cold and Heat tolerance such as a USDA Hardiness Zone. The recitation "High" is vague and insufficient in this regard.

V. Applicants should set forth in the specification information relative to the instant plant's Pest Resistance/Susceptibility.

W. Page 9, The Claim, line 7, Applicants should delete "being" and insert - having- - as this term is more appropriate in this instance. Applicants could simplify The Claim further by simply stating - A new and distinct variety of Petunia plant, substantially as herein illustrated and described.- - as this claim encompasses the entire plant which is described in the specification including the characteristics set forth in (A) through (D) of the current claim.

### **Detailed Action**

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

### **Claim Rejection**

#### **35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

### **Comments**

Applicants should note the new amendment format which is now mandatory (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

Applicants should send all correspondence to the following address:

COMMISSIONER FOR PATENTS  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450

Serial Number: 10/650,460  
Art Unit: 1661

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### **Detailed Action**

#### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (571) 272-0974.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT BELL  
PRIMARY EXAMINER**

*Kent L. Bell*